

Board of Appeals
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of)	
)	
Marc ALIZON et al.)	Group Art Unit: 1648
)	
Serial No.: 08/466,921)	Examiner: J. PARKIN
)	
Filed: June 6, 1995)	
)	
For: HIV-1 DNA FRAGMENTS)	
THAT HYBRIDIZE TO)	Appeal No.: 2005-0256
GENOMIC HIV-1 DNA)	
(AS AMENDED))	

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING

Pursuant to 37 C.F.R. § 41.52, Appellants request rehearing
and reversal of the Decision On Appeal dated September 26, 2005.

REMARKS

Reconsideration of the Decision On Appeal dated September 26, 2005, is respectfully requested. The Board misapprehended or overlooked the relevance of broad disclosures in Appellants' specification regarding the claimed HIV-1 DNA fragments. These broad disclosures, together with the explicit disclosure of the specific hybridization conditions claimed, are sufficient to fulfill the written description requirement of 35 U.S.C. § 112.

The Board has overlooked the impact of broad teachings in Appellants' specification

In its Decision, the Board takes the position that, although Appellants' specification describes the hybridization conditions recited in Appellants' claims on appeal, these conditions were used for a different purpose, namely, to compare HIV with a number of human endogenous viral genomes. The Board does not discuss the impact of numerous broad teachings in Appellants' specification, commenting only that "it appears that appellants have cobbled together disparate portions of the original disclosure" (Decision at 5.) However, nearly the entirety of Appellants' specification relates to cloned HIV-1 DNAs and the hybridization of these DNAs to HIV-1 nucleic acids. When Appellants' specification is considered "as a whole," the impact of Appellants' broad teachings becomes apparent.

The first sentence in Appellants' specification states that the invention broadly relates to "DNA sequences hybridizable to genomic RNA and DNA" of HIV-1. (Specification at 1, lines 1-3.) In other words, the invention encompasses HIV-1 DNA sequences that can hybridize to HIV-1 DNAs. Since the first sentence of Appellants' specification does not specify particular conditions of hybridization, the skilled artisan would have understood that the invention was not limited to particular hybridization conditions, but that many suitable hybridization conditions were included within the scope of Appellants' invention. The skilled artisan would then turn to other sections of the specification to identify particular conditions of hybridization contemplated by the inventors.

On pages 2-5, Appellants' specification teaches a plethora of HIV-1 DNA fragments and that all of the fragments have in common "the capability of hybridizing with the retroviral genome." (*Id.* at 5, lines 13-15.) In other words, the specification teaches that Appellants contemplated HIV-1 DNA fragments that could hybridize to HIV-1 DNA. Once again, since this passage does not specify particular conditions of hybridization, the skilled artisan would turn to other sections of the specification to identify particular conditions of hybridization contemplated by the inventors. The specification

provides a number of suitable hybridization conditions for use with HIV-1 DNA fragments.

On page 9, Appellants' specification teaches particular conditions of hybridization of a HIV-1 DNA fragment to HIV-1 DNAs. (*Id.* at 9, lines 1-25.) Since the described hybridization conditions were used successfully with HIV-1 fragments to identify HIV-1 DNAs, the skilled artisan would have understood that these were suitable hybridization conditions contemplated by the inventors for use with HIV-1 DNA fragments.

On page 11, Appellants' specification teaches particular conditions of hybridization of HIV-1 DNA fragments under which no hybridization to HTLV-II DNAs was detected. (*Id.* at 11, lines 19-34.) The conditions used are similar to those recited in the claims on appeal. Since these conditions were less stringent than the conditions on page 9, and no hybridization of HIV-1 DNA fragments to HTLV-II was detected under these conditions, the skilled artisan would have understood that these were suitable hybridization conditions contemplated by the inventors for use with HIV-1 DNA fragments.

Also, on page 12, Appellants' specification teaches particular conditions of hybridization of HIV-1 DNA fragments under which no hybridization to human endogenous viral genomes was detected. (*Id.* at 12, lines 2-7.) The conditions used are recited in the claims on appeal. Since these conditions were

less stringent than the conditions on page 9, and no hybridization of HIV-1 DNA fragments to human endogenous viral genomes was detected, the skilled artisan would have understood that these were suitable hybridization conditions contemplated by the inventors for use with HIV-1 DNA fragments. Although the burden is on the PTO and not on Appellants, the Board has presented no reasons why, in view of the broad teachings of the specification, the skilled artisan would find these conditions, which are explicitly recited in the specification, inapplicable.

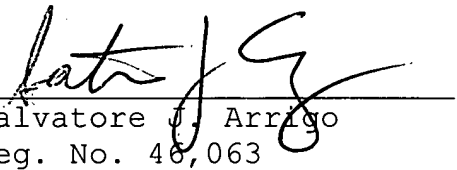
The relevance of numerous broad teachings in Appellants' specification is not discussed by the Board in its Decision. When these broad teachings of Appellants' specification are taken into consideration, the skilled artisan would have been directed to the claimed hybridization conditions. For these reasons, Appellants request reversal of the Decision.

Please grant any extensions of time required to enter this request and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

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